

REMARKS

Claims 1-22, 24-27, 29-39, 41-42, 45 and 48-51 remain pending in the application with the present amendments. In the Official Action, the Examiner rejected the claims under 35 U.S.C. §103 as being obvious over U.S. Patent No. 6,361,396 B1 issued March 26, 2002 to Snyder et al., ("Snyder"), U.S. Patent No. 6,290,566 B1 to Gabai et al. issued September 18, 2004 ("Gabai"), U.S. Patent No. 6,207,311 to Lastinger issued August 15, 2000 ("Lastinger"), U.S. Patent No. 5,661,470 to Karr issued August 16, 1997 ("Karr"), and/or U.S. Patent No. 6,380,844 B2 to Pelekis issued April 30, 2002 ("Pelekis"). For the reasons set forth below, Applicant submits that the presently pending claims are fully distinguished over the references cited by the Examiner, and respectfully requests reconsideration and allowance thereof at this time.

The presently pending claims set forth an invention in which a toy is operable to emit a query electromagnetic wave and a mobile item is operable to produce an answer electromagnetic wave in response to the query electromagnetic wave. As recited in claim 1, an interaction circuit included in the toy is operable to select a first user-defined output based on receiving an associated answer electromagnetic wave, and to simultaneously select a second output based on receiving a particular answer electromagnetic wave. The interaction circuit causes the toy to output in a user-perceptible manner, the selected user-defined output combined with the simultaneously selected second output. Similar recitations are found in the independent apparatus claim 9 and method claim 26.

Thus, in an example of operation, as described in Applicant's specification at pg. 11, ¶ [0030], a user-defined output can be in the form of a phrase such as "John". The toy is operable to associate one or more answer electromagnetic waves with the user-defined output such that "John" is selected when

the toy senses such answer electromagnetic wave. A second output can be in the form of a phrase such as "It's time for bed." The toy is operable to simultaneously select the second output based on receiving a particular answer electromagnetic wave. The toy is further operable to output the user-defined phrase "John" combined together with the simultaneously selected second phrase "it's time for bed" when both the associated answer electromagnetic wave and the answer electromagnetic wave for a particular RF tag are received. Accordingly, the toy would answer "John, it's time for bed."

This feature of the invention is not reflected at all in *Snyder* and *Gabai* that are cited by the Examiner. Both *Snyder* and *Gabai* merely describe toys which provide one output at a time in response to an external stimulus. None of the cited references teach or suggest a toy which outputs a selected user-defined output, selected by an answer electromagnetic wave associated therewith, combined with the simultaneously selected second output which is selected by another particular answer electromagnetic wave.

Moreover, the cited references provide no motivation for their teachings to be combined in the manner stated by the Examiner to reject the claims. Only by impermissible hindsight, with knowledge of the applicant's invention, can the teachings of *Snyder*, which relate to a toy producing one output in response to one electromagnetic wave at a time, be combined with the teachings of *Gabai* concerning another toy which produces one output at a time, to reconstruct applicant's invention.

Further, applicant respectfully submits that the remaining cited references, neither alone nor in combination, teach or suggest the invention that is claimed in amended claims 1, 9 and 26. *Lastinger* merely describes a system in which articles include radio frequency tags. *Karr* merely describes a system in which the toy distinguishes between articles based on

the content of electromagnetic waves emitted by the articles. *Pelekis* merely describes a system in which a doll responds differently to transmitters located at different locations of a house. However, none of the references cited by the Examiner either teach or suggest selecting a user-defined output based on receiving one or more associated electromagnetic waves and simultaneously selecting a second output based on receiving a particular one or more electromagnetic waves, and outputting, in a user-perceptible manner, the user-defined phrase combined with the second selected output.

As to other claims amended herein, claims 19 and 50 are voluntarily amended to remove certain informalities and not for a reason substantially related to their patentability. Claim 4 is amended to state that the phrases selected by the respective answer electromagnetic waves are combined and outputted by the toy in an order resembling human speech.

The combination of the cited references neither teaches nor suggests producing such combined output when the user-defined output is a user-defined phrase and the second output is a second phrase, as recited in claims 4, 21 and 30, and as specifically claimed in claim 4, in an order *resembling human speech*. Nor does the combination of cited references teach or suggest that the user-defined phrase is associated with the one or more electromagnetic waves by the user selecting one or more of the mobile items as recited in claims 8 and 32.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 09/803,250

Docket No.: SONY 3.0-042

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 27, 2004

Respectfully submitted,

By 

Daryl K. Neff

Registration No.: 38,253

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant

502804_1